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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,089	01/18/2006	Andreas Schmidt	P33653US	5419
81722 7590 07/21/2009 Viering, Jentschura & Partner 3770 Highland Ave. Suite 203 Manhattan Beach, CA 90266				
EXAMINER				
HUYNH, NAM TRUNG				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

vjp-us@vjp.de
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Office Action Summary

Application No.

10/565,089

Applicant(s)

SCHMIDT ET AL.

Examiner

NAM HUYNH

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 19 and 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 4/2/09. Of the previously presented claims 18-32; claims 18 and 32 were amended and claim 20 has been cancelled.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 18-20, 22, and 24-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aho (US 2001/0005675) in view of Gupta et al. (US 6,657,667) (hereinafter Gupta).

Regarding claim 18, Aho teaches a method for transmitting a useful data object (multimedia message) from a switching component (MMSC) to a mobile station, comprising:

selecting at least one communication network in which the useful data object is to be transmitted (paragraphs 47, 51, 55, 74; The GGSN is located within the GPRS cellular network and the MMSC is located outside the GPRS cellular network such as the IP network of the operator. The message is sent to the mobile station from the GGSN and thus is sent in the GPRS cellular network. The Examiner takes the position that "selecting at least one communication network" occurs because the MMSC lies outside the GPRS network and the message is sent via the GPRS network thus showing that a network is selected); and

transmitting the useful data object from the switching component to the mobile station when it is determined that the mobile station is registered in the at least one selected communication network (paragraphs 53, 63; The message is sent to the mobile station if it is ready to receive data (i.e. a PDP-context is active with the GGSN). An active connection shows that the mobile station has registered with the network and in this case it is the GPRS network), and it is determined that the switching component has a delivery request for the useful data object (figure 3, item 31).

Aho does not explicitly teach that the at least one communication network in which the useful data object is to be transmitted is selected at the mobile station, with aid of a selection device, the selection device being assigned to the mobile station, and stored in a storage unit assigned to the mobile station. Gupta discloses a domain

selecting system and method (title). Gupta teaches that a user equipment (mobile station) can decide the domain (network; i.e. IP network or mobile switching network) it wants to be serviced for a particular message (transmission of a data object) or session. The decision can be made using a resident (assigned) user input/output (selection device) and the selection may be stored in resident (assigned) user equipment memory or a SIM (storage unit) (column 4, lines 20-26, 46-54; figure 2). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aho to allow the terminal to be able to select the network for receiving data objects, as taught by Gupta, in order to transparently migrate services from one domain, or network, to another thus adding flexibility to the user for utilizing services.

Regarding claim 19, Aho teaches the mobile station is notified by the switching component when the switching component has a useful data object for the mobile station (paragraph 77).

Regarding claim 20, Aho teaches the at least one communication network is selected with the aid of a selection device, with the selection device being assigned to the mobile station or the switching component (paragraph 69).

Regarding claim 21, Gupta teaches the at least one communication network is selected as a function of at least one parameter, the parameter comprises one of cost of transmitting the useful data object, transmission time for the useful data object, size of the useful data object, the sender of the useful data object, and the nature of the useful data object (column 5, lines 45-58).

Regarding claim 22, Aho teaches the step of determining whether the mobile station has registered in one of the selected communication networks is performed by a determination device (GGSN) assigned to the mobile station or the switching component (paragraph 63).

Regarding claim 24, Aho teaches the mobile station sends the switching component the delivery request for the useful data object, either when it is determined by the mobile station that the mobile station has registered in one of the selected communication networks, or the mobile station is notified by the determination device assigned to the switching component that the mobile station has registered in one of the selected communication networks (paragraph 77).

Regarding claim 25, Aho teaches the switching component transmits the useful data object to the mobile station when the delivery request for the useful data object is sent from the mobile station to the switching component or the switching component already has a delivery request (figure 3, item 31).

Regarding claim 26, Aho teaches the useful data object is transmitted as a multimedia message in the context of the multimedia messaging service between the switching component and the mobile station (paragraph 76).

Regarding claim 27, Aho teaches the mobile station displays to a user, on receipt of a notification that a useful data object is available, the option of selecting from at least two of the following options: transmitting the useful data object from the switching component immediately, at a later time or after registration of the mobile station in the

home network or in a previously selected network outside the home network (paragraph 77).

Regarding claim 28, Aho teaches the useful data object is sent from a data provision component (IP network) to the switching component for transmission to the mobile station (paragraph 55).

Regarding claim 29, Aho teaches at least one of the following information items contained in the useful data object is stored in a storage unit assigned to the mobile station: a status of the transmission process of the useful data object, the at least one selected communication network, a selected parameter(s), notification and messages, information specific the useful data object (paragraph 77).

Regarding claim 30, Aho teaches the storage unit assigned to the mobile station is a SIM card or a UICC card with a USIM application (paragraph 59).

Regarding claim 31, Aho teaches the storage, the receiving and sending of the useful data object, the selection of the communication network, the selection of the parameters and/or the display on the mobile station are executed by a software application on the mobile station (paragraph 77).

Regarding claim 32, the limitations are rejected as applied to claim 18.

4. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aho (US 2001/0005675) in view of Gupta et al. (US 6,657,667) (hereinafter Gupta), as applied to claim 22, and further in view of Dorenbosch et al. (US 2003/0217174) (hereinafter Dorenbosch).

The combination of Aho and Gupta teaches the limitations set forth in claim 22, but does not explicitly teach the determination device notifies the mobile station that the mobile station has registered in one of the selected communication networks, when it is determined either by the switching component or by the assigned communication device that the mobile station has registered in one of the selected communication networks. Dorenbosch discloses an apparatus and method for establishing an IP session between a host and a mobile station (abstract). Dorenbosch teaches that a determination device (registrar) notifies the mobile station that the mobile station has registered (registration acknowledgment) in one of the selected communication networks, when it is determined either by the switching component or by the assigned communication device that the mobile station has registered in one of the selected communication networks (paragraph 26). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the GGSN of the combination of Aho and Gupta to include the notification of registration in initially setting up the connection, as taught by Dorenbosch, in order to allow the mobile station to conduct whatever transaction it wishes via the packet data network, for example read email, browse the Web or even receive push material from the host.

Response to Arguments

5. Applicant's arguments with respect to claims 18, 19, and 21-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

/Nam Huynh/
Examiner, Art Unit 2617